



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,632	12/26/2001	Timothy J. Brennan	P05435US0	9250
22885	7590	07/21/2004	EXAMINER	
MCKEE, VOORHEES & SEASE, P.L.C. 801 GRAND AVENUE SUITE 3200 DES MOINES, IA 50309-2721			GEORGE, KONATA M	
			ART UNIT	PAPER NUMBER
			1616	

DATE MAILED: 07/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

MAILED

JUL 21 2004

GROUP 1600

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 1262004

Application Number: 10/033,632
Filing Date: December 26, 2001
Appellant(s): BRENNAN, TIMOTHY J.

Edmund J. Sease
Reg. No. 24,741
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed November 21, 2003.

Art Unit: 1616

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

Art Unit: 1616

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1-5 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,670,516

ARNOLD et al.

9-1997

Conn M.D., Howard Current Therapy Latest Approved Methods of Treatment For the Practicing Physician, (1977), pp. 825, 830-831

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arnold (US 5,670,516) in view of Current Therapy (1977).

Arnold discloses in claims 36 and 37, column 88, lines 38-44 a formulation comprising a pharmaceutically acceptable carrier together with 6-[2-(1(2)H-tetrazole-5-yl)ethyl] decahydroisoquinoline-3-carboxylic acid or a pharmaceutically acceptable salt thereof. Column 36, lines 11-12, discloses that the compounds can be used as analgesic agents and column 35, lines 33-38, teaches that the compound can be administered from about 0.01 mg/kg to about 20 mg/kg preferably about 0.1 to about

Art Unit: 1616

0.5 mg/kg. Column 35, line 46, teaches the many different types of physiological functions that compound can treat, one of which is spinal cord trauma. The prior art of Arnold does not teach the route of administration being intrathecal.

On page 830 of Current Therapy describes methods of spinal anesthesia delivery. The last line in the first column through the 3rd line of the second column teaches that a needle is inserted at L3-4, on the vertical line through the interspace but 1 cm below the ridge of the osseomuscular spinal column.

It would have been obvious to one of ordinary skill to use the teachings of Current Therapy to select intrathecal administration as the best mode for the purposes of delivery an anesthesia to the spinal cord. As describe on page 830 it is known in the art that when administering an anesthesia to the spinal cord that it would be done by way of intrathecal administration and example of such a practice is administering a drug during pregnancy.

(11) Response to Argument

Applicant argues that Arnold teaches the use of 6-[2-(1(2)H-tetrazole-5-yl)ethyl] decahydroisoquinoline-3-carboxylic acid as an analgesic agent not as an anesthesia and that there is no mention of the compound as an anesthesia in Current Therapy (1997), therefore there is no suggestion to combine.

It is the position of the examiner that although Arnold does not specifically teach that 6-[2-(1(2)H-tetrazole-5-yl)ethyl] decahydroisoquinoline-3-carboxylic acid can be used as an anesthesia, it would also function as an anesthesia as the compounds are

Art Unit: 1616

the same. With respect to the prior art of "Current Therapy" as mentioned in the final rejection, the "Current Therapy" reference is used merely to teach the mode of delivering drugs, anesthetics, etc. to the spinal cord. It was never mentioned that "Current Therapy" taught that the compound was used as an anesthesia.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

KG
Konata M. George
June 1, 2004

Conferees


SHELLEY A. DODSON
PRIMARY EXAMINER

MCKEE, VOORHEES & SEASE, P.L.C.
801 GRAND AVENUE
SUITE 3200
DES MOINES, IA 50309-2721


THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER